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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/200,853	11/30/1998	YASUHIRO YAMAMOTO	P17029	9849

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EXAMINER

GHEE, ASHANTI

ART UNIT PAPER NUMBER

2626

DATE MAILED: 09/10/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/200,853

Applicant(s)

YAMAMOTO, YASUHIRO

Examiner

Ashanti Ghee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-12 is/are rejected.
- 7) ☒ Claim(s) 3,13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to the following communications: amendment C filed on 6/13/03.
2. This application has been reconsidered. Claims 1-15 are pending.

Response to Arguments

3. Applicant's arguments with respect to claim 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 12 recites the limitation "said image data recording processor" in line 9 of the claim. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 12 recites the limitation "said image data transmitting device" in line 11 of the claim. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 12 recites the limitation "said determining device" in line 12 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2, 4-5^{II} and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato et al. (US Patent No. 5,898,824).

Regarding ^{claims I & II} ~~claim 4~~, Kato discloses an image reading device comprising: a housing (Fig. 1); a reading processor (CCD scanner 16 reads on reading processor) that optically reads an image recorded (inherent that capturing images reads on optically reads an image recorded) on a recording material sheet (inherent that original document reads on recording material sheet since a document is generated from a sheet of paper) to generate an image (produces image data reads on generate image data; col. 6, lines 34-48); an image data transmitting processor (CPU 10 reads on image data processor; col. 5, lines 51-55) that can transmit (facsimile transmission reads on transmit) said image data (image data) externally to a peripheral device (personal computer 2 reads on externally to a peripheral device; col. 8, lines 7-46); an image data recording processor (CPU 10 reads on image data processor; col. 5, lines 51-55) that can record (store reads on record) said image data (image data) in a recording medium (RAM 15 reads on recording medium) mounted in said housing (col. 6, lines 34-48); a

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recording operation determination processor (CPU 10 reads on image data processor; col. 5, lines 51-55) that determines (checks reads on determines), based on a state of said recording medium (if there is an available storage capacity in RAM 15 reads on state of said recording medium; col. 8, lines 50-col. 11, lines 1-36), whether a recording operation (memory reception reads on recording operation) of said image data recording processor (10) is possible (is carried out reads on is possible; col. 10, lines 50-column 11, lines 1-47); and a control processor (CPU 10 reads on image data processor; col. 5, lines 51-55) that, when said recording operation determination processor (10) determines (checks) that said recording operation (storage capacity in RAM 15 reads on recording operation) is impossible (no available storage capacity reads on is impossible; col. 10, lines 50-col. 11, lines 1-36), prohibits said recording operation (memory reception cannot be accomplished reads on prohibits said recording operation) and allows said image data transmitting processor (10) to transmit said image data (reception data reads on image data) to said peripheral device (col. 10, lines 50-column 11, lines 1-27).

Regarding claim 2, Kato discloses a device further comprising a display device (LCD 22 reads on display device) that indicates said recording operation (storing reads on recording operation) is prohibited (fax memory has become full reads on recording operation is prohibited) when said recording operation determination processor (10) determines that said recording operation is impossible (col. 8, lines 49-col. 9, lines 1-25).

Regarding claim 4, Kato discloses a device wherein said recording operation determination processor (10) determines whether said recording operation (storing reads on recording operation) is possible based on a remaining recordable volume (fax memory reads on recordable volume) of said recording medium (col. 8, lines 49-col. 9, lines 1-25).

Regarding claim 5, Kato discloses a device wherein said recording operation determination processor (10) determines whether said recording operation (storing reads on recording operation) is possible based on a formatting state (available storage capacity in the RAM 15 reads on formatting state of said recording medium) of said recording medium (col. 10, lines 50-col. 11, lines 1-36).

Regarding claim 12, Kato discloses an image reading device comprising: a device (CCD scanner 16) that optically reads an image recorded (inherent that capturing images read on optically reads an image recorded has been performed) on a recording material sheet (inherent that original document reads on recording material sheet) to generate image data (produces image data reads on generate image data; col. 6, lines 34-48); a device (I/O port 3; col. 5, lines 39-43) that transmits said image data (image data reads on image data) to a computer (personal computer 2 reads on computer) provided externally to said image reading device (facsimile machine 1 reads on image reading device; col. 10, lines 50-col. 11, lines 1-36); a recorder (CPU 10; col. 5, lines 51-55) that records (store reads on records) said image data (image data reads on image data) in a recording medium (RAM 15 reads on recording medium) mounted in said image reading device (col. 10, lines 50-col. 11, lines 1-36); a device (CPU 10;

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col. 5, lines 51-55) that determines (checks reads on records), based on a state of said recording medium (if there is an available storage capacity in RAM 15 reads on state of said recording medium; col. 8, lines 50-col. 11, lines 1-36), whether a recording operation (memory reception reads on recording operation) of said image data recording processor is possible (is carried out reads on is possible; col. 10, lines 50-col. 11, lines 1-36); and a device (10) that controls said transmitting device (3) and said recording device (10) and prohibits said recording operation (memory reception cannot be accomplished reads on prohibits said recording operation) and allows said image data transmitting device to transmit said image data (image data) to said computer (2) when said determining device determines (checks) that said recording operation (storage capacity in RAM 15 reads on recording operation) is impossible (no available storage capacity reads on is impossible; col. 10, lines 50-column 11, lines 1-27).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent No. 5,898,824) in view of Moronaga et al. (US Patent No. 5,473,370).

Regarding claim 6, Kato does not specifically disclose a device wherein said recording operation determination processor determines whether said recording operation is possible based on a type of said recording medium.

However, Moronaga discloses a device wherein said recording operation determination processor determines whether said recording operation is possible based on a type of said recording medium (col. 9, lines 36-42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Moronaga and Kato due to both disclosing an image reading device to greatly simplify the operation for the user.

Regarding claim 7, Kato does not specifically disclose a device wherein said recording medium comprises a memory card. However, Moronaga discloses a device wherein said recording medium comprises a memory card (col. 24, lines 24-26).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Moronaga due with the teachings of Kato due to both disclosing an image reading device to greatly simplify the operation for the user.

Regarding claim 8, Kato does not disclose a device wherein said memory card comprises a PC card. However, Moronaga discloses a device wherein said memory card comprises a PC card (col. 24, lines 24-26).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Moronaga with the

teachings of Kato due to both disclosing an image reading device to greatly simplify the operation for the user.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent No. 5,898,824) in view of Suzuki (US Patent No. 6,347,162).

Regarding claim 9, Kato does not disclose a device wherein said recording medium comprises a magneto-optical disc. However, Suzuki discloses a device wherein said recording medium comprises a magneto-optical disc (col. 7, lines 35-37).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Suzuki with the teachings of Kato due to both disclosing image reading devices to provide prompt and simple operation.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent No. 5,898,824) in view of Hirai et al. (US Patent No. 5,315,403).

Regarding claim 10, Kato does not disclose a device wherein said recording medium comprises a magnetic disk. However, Hirai discloses a device wherein said recording medium comprises a magnetic disk (col. 3, lines 26-29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Hirai with the teachings of Kato due to both disclosing an image reading device to provide a storage medium

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having the high storage speed to transfer image information to a storage medium

having a low speed.

Allowable Subject Matter

14 ~~15~~ Claims 3 and 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15 ~~16~~ Claim 15 is allowed.

16 ~~17~~ The following is a statement of reasons for the indication of allowable subject matter: Claim 15 are allowable over the prior art of record because the Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of the said prior art which teaches an image reading device that comprises a housing, a reading processor, an image data transmitting processor, an image

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recording processor that is configured to record the image data in a detachable/reattachable recording medium to the housing, a recording operation determination processor, and a control processor, respectively, as set forth in Claim 15 including all of the features recited therein.

Conclusion

17 18 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Murata (US Patent No. 6,606,161 B2) discloses a digital copying machines and image readers with offline interface.

Someya et al. (US Patent No. 6,219,152 B1) discloses a printer and information processing apparatus.

Satou (US Patent No. 6,144,459) discloses a facsimile machine adapted to reduce risk of data loss.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashanti Ghee whose telephone number is (703) 306-3443. The examiner can normally be reached on Mon-Thurs and alt. Fri. (7-4PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

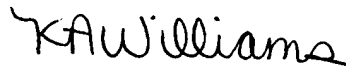
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



AG
September 7, 2003

Ashanti Ghee
Examiner
Art Unit 2626



Kimberly A. Williams
Primary Examiner
Technology Center 2600